No. 18-302

In the Supreme Court of the United States

ANDREI IANCU, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

ERIK BRUNETTI

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE PETITIONER

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QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises immoral * * * or scandalous matter." The question presented is as follows:

Whether Section 1052(a)'s prohibition on the federal registration of "immoral" or "scandalous" marks is facially invalid under the Free Speech Clause of the First Amendment.

TABLE OF CONTENTS

Page

Opinions below 1
Jurisdiction 1
Constitutional and statutory provisions involved 2
Statement 2
Summary of argument 11
Argument:
The scandalous-marks provision in 15 U.S.C. 1052(a) is facially constitutional under the First Amendment 14
A. This Court's decision in *Tam* is limited to trademark-registration criteria that discriminate based on viewpoint 15
B. Because the scandalous-marks provision is a viewpoint-neutral condition on a government benefit whose availability necessarily turns on the content of an applicant's speech, the court of appeals erred in subjecting that provision to strict scrutiny 19
1. The scandalous-marks provision does not restrict speech, but simply imposes a condition on the availability of a government benefit 20
2. Administration of the federal trademark-registration program inherently and necessarily requires the government to draw distinctions based on the content of applicants' marks 25
3. The scandalous-marks provision is viewpoint-neutral 26
C. The scandalous-marks provision is reasonably related to legitimate government interests and does not reach outside the federal trademark-registration program 31

Table of Contents—Continued: Page

1. A ban on registration of scandalous marks is a longstanding and reasonable means of vindicating legitimate government interests 32
2. The scandalous-marks provision does not subject respondent or similarly situated persons to any adverse legal consequences outside the trademark-registration program 38
D. The court of appeals' contrary reasoning is erroneous 40
1. The court of appeals erred in treating the scandalous-marks provision as a restriction on speech 40
2. The court of appeals erred in treating as irrelevant this Court's decisions involving government-established subsidies and forums 41
3. A decision sustaining the scandalous-marks provision against respondent's First Amendment challenge would have no necessary implications for the constitutionality of analogous limits on copyright registration 43
4. The court of appeals' concern that the scandalous-marks provision has been applied inconsistently provides no basis for invalidating that provision 45
Conclusion 48
Appendix — Statutory provisions 1a

TABLE OF AUTHORITIES

Cases: Page

Abood v. *Detroit Bd. of Educ.*, 431 U.S. 209 (1977) 42
Agency for Int'l Dev. v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205 (2013) 12, 23, 31, 32, 38, 40
American Freedom Def. Initiative v. *Washington Metro. Area Transit Auth.*, 901 F.3d 356 (D.C. Cir. 2018), petition for cert. pending, No. 18-1000 (filed Jan. 28, 2019) 30
B & B Hardware, Inc. v. *Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015) 2, 3, 4, 20
Bethel Sch. Dist. No. 403 v. *Fraser*, 478 U.S. 675 (1986) 29
Boulevard Entm't, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003) 23, 27, 46
Broadrick v. *Oklahoma*, 413 U.S. 601 (1973) 47
Central Hudson Gas & Elec. Corp. v. *Public Serv. Comm'n*, 447 U.S. 557 (1980) 10, 37
Christian Legal Soc'y Chapter of the Univ. of Cal., Hastings Coll. of the Law v. *Martinez*, 561 U.S. 661 (2010) 22, 24
Cohen v. *California*, 403 U.S. 15 (1971) 29
Cornelius v. *NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788 (1985) 23, 35
Dastar Corp. v. *Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) 44
Davenport v. *Washington Educ. Ass'n*, 551 U.S. 177 (2007) 19, 22, 23, 41, 42
De Walt, Inc. v. *Magna Power Tool Corp.*, 289 F.2d 656 (C.C.P.A. 1961) 46
Eldred v. *Ashcroft*, 537 U.S. 186 (2003) 44
FCC v. *Pacifica Found.*, 438 U.S. 726 (1978) 28, 33

Cases—Continued: Page

Fox, In re, 702 F.3d 633 (Fed. Cir. 2012) 26, 27
Friedman v. *Rogers*, 440 U.S. 1 (1979) 36
General Media Commc'ns, Inc. v. *Cohen*, 131 F.3d 273 (2d Cir. 1997), cert. denied, 524 U.S. 951 (1998) 30
Griffin v. *Department of Veterans Affairs*, 274 F.3d 818 (4th Cir. 2001), cert. denied, 537 U.S. 947 (2002) 30
Janus v. *AFSCME*, 138 S. Ct. 2448 (2018) 42
Maher v. *Roe*, 432 U.S. 464 (1977) 22
Matal v. *Tam*, 137 S. Ct. 1744 (2017) ..... *passim*
McGinley, In re, 660 F.2d 481 (C.C.P.A. 1981) ..... *passim*
Miller v. *California*, 413 U.S. 15 (1973) 28, 45
Mishawaka Rubber & Woolen Mfg. Co. v. *S. S. Kresge Co.*, 316 U.S. 203 (1942) 3, 36
Mitchell Bros. Film Grp. v. *Cinema Adult Theater*, 604 F.2d 852 (5th Cir. 1979), cert. denied, 445 U.S. 917 (1980) 45
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) 18
PMG Int'l Div., L.L.C. v. *Rumsfeld*, 303 F.3d 1163 (9th Cir. 2002) 30
Park 'N Fly, Inc. v. *Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985) 5, 20, 22
Perry v. *McDonald*, 280 F.3d 159 (2d Cir. 2001) 29
Perry Educ. Ass'n v. *Perry Local Educators' Ass'n*, 460 U.S. 37 (1983) 12, 25
Prestonettes, Inc. v. *Coty*, 264 U.S. 359 (1924) 3, 37
Qualitex Co. v. *Jacobson Prods. Co.*, 514 U.S. 159 (1995) 3, 34

Cases—Continued: Page

R. A. V. v. *City of St. Paul*, 505 U.S. 377 (1992) 12, 20, 27, 28
Reed v. *Town of Gilbert*, 135 S. Ct. 2218 (2015) 19
Regan v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983) 9, 23, 31, 43
Riverbank Canning Co., In re, 95 F.2d 327 (C.C.P.A. 1938) 27
Rosenberger v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819 (1995) 17, 18, 30, 31
Runsdorf, In re, 171 U.S.P.Q. 443 (T.T.A.B. 1971) 27
Rust v. *Sullivan*, 500 U.S. 173 (1991) 23, 25, 32, 45
San Francisco Arts & Athletics, Inc. v. *United States Olympic Comm.*, 483 U.S. 522 (1987) 36
Shinnecock Smoke Shop, In re, 571 F.3d 1171 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010) 46
St. Helena Hosp., In re, 774 F.3d 747 (Fed. Cir. 2014) 46
Trade-Mark Cases, In re, 100 U.S. 82 (1879) 3, 21
Trinity Lutheran Church of Columbia, Inc. v. *Comer*, 137 S. Ct. 2012 (2017) 31
Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992) 39
United States v. *American Library Ass'n*, 539 U.S. 194 (2003) 33
United States v. *Playboy Entm't Grp., Inc.*, 529 U.S. 803 (2000) 40, 41
United States v. *Stevens*, 559 U.S. 460 (2010) 47
Wal-Mart Stores, Inc. v. *Samara Bros.*, 529 U.S. 205 (2000) 2, 34, 36, 44
Ysursa v. *Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) ..... *passim*

Constitution, treaties, and statutes: Page

U.S. Const.:
Art. I, § 8 (Spending Clause) 9, 43
Amend. I ..... *passim*
Free Speech Clause 2, 11, 16, 31
General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(3), 46 Stat. 2914, T.S. No. 833 32
Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 (U.S. accession effective May 30, 1887) 32
Paris Convention for the Protection of Industrial Property, July 14, 1967, Art. 6^{quinquies}, 21 U.S.T. 1643, 828 U.N.T.S. 331 35
Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 210-212 4
Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 4
§ 5, 33 Stat. 725 ..... 6, 25, 32
Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) 4
15 U.S.C. 1051(a)(1) 5, 24, 35, 1a
15 U.S.C. 1051(a)(2) 5, 1a
15 U.S.C. 1052 ..... 25, 7a
15 U.S.C. 1052(a) ..... *passim*, 7a
15 U.S.C. 1052(b) 5, 25, 7a
15 U.S.C. 1052(c) 5, 25, 7a
15 U.S.C. 1052(d) 5, 25, 8a
15 U.S.C. 1052(e)(1) 5, 25, 9a
15 U.S.C. 1052(e)(5) 5, 25, 9a
15 U.S.C. 1057(a) 5, 35, 10a
15 U.S.C. 1057(b) 4, 21, 11a
15 U.S.C. 1062 ..... 35, 14a
15 U.S.C. 1063 46

Statutes—Continued: Page

15 U.S.C. 1064 46
15 U.S.C. 1065 ..... 5, 21, 16a
15 U.S.C. 1067 46
15 U.S.C. 1070 46
15 U.S.C. 1071 46
15 U.S.C. 1072 ..... 4, 21
15 U.S.C. 1091 35
15 U.S.C. 1111 ..... 5, 35, 17a
15 U.S.C. 1114(1)(a) 4, 18a
15 U.S.C. 1115(a) 4, 21, 19a
15 U.S.C. 1115(b) 5, 21, 20a
15 U.S.C. 1116-1118 21
15 U.S.C. 1117(a) 24, 39, 22a
15 U.S.C. 1124 21
15 U.S.C. 1125(a) 4, 39, 25a
15 U.S.C. 1125(a)-(d) 21
15 U.S.C. 1125(a)(1) 24, 39, 25a
15 U.S.C. 1125(b) 4, 24, 39, 26a
15 U.S.C. 1125(c) 4, 24, 27a
15 U.S.C. 1125(c)-(d) 39
15 U.S.C. 1125(d) 4, 24, 31a
15 U.S.C. 1141b 35
17 U.S.C. 102(a) 44
35 U.S.C. 2(a)(1) 5

Miscellaneous:

1 Anne Gilson LaLonde, *Gilson on Trademarks* (2014) 3, 4
Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 Trademark Rep. 1476 (2011) 32

Miscellaneous—Continued: Page

3 J. Thomas McCarthy, *Trademarks and Unfair Competition* (5th ed. 2018) 4

Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172 (2013) 32

Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. Davis L. Rev. 2331 (2018) 33

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-54a) is reported at 877 F.3d 1330. The opinion of the Trademark Trial and Appeal Board (Pet. App. 55a-67a) is available at 2014 WL 3976439.

JURISDICTION

The judgment of the court of appeals was entered on December 15, 2017. A petition for rehearing was denied on April 12, 2018 (Pet. App. 68a-69a). On July 5, 2018, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including August 10, 2018. On July 31, 2018, the Chief Justice further extended the time to and including September 7, 2018, and the petition was filed on that date. The petition for a

writ of certiorari was granted on January 4, 2019. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The First Amendment provides in pertinent part that "Congress shall make no law * * * abridging the freedom of speech." U.S. Const. Amend. I. Relevant statutory provisions are reprinted in an appendix to this brief. App., *infra*, 1a-38a.

STATEMENT

This case involves a facial First Amendment challenge to a century-old provision of federal trademark law that directs the United States Patent and Trademark Office (USPTO) to refuse registration of trademarks containing "scandalous" or "immoral" matter. 15 U.S.C. 1052(a). Respondent sought federal registration for the mark "FUCT" in connection with a clothing line including children's and infants' apparel. The USPTO refused registration under Section 1052(a) based on evidence that the mark would be perceived as equivalent to the vulgar word for which it is a homonym. Pet. App. 55a-67a. The court of appeals agreed that the mark is "scandalous" within the meaning of Section 1052(a), but the court struck down the provision denying federal registration of scandalous or immoral marks as facially invalid under the Free Speech Clause of the First Amendment. *Id.* at 1a-54a.

1. "The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); see *Wal-Mart Stores, Inc.* v. *Samara Bros.*, 529 U.S. 205, 212 (2000) (explaining that the "predominant function"

of a trademark is "source identification"). By preventing others from copying such marks, trademark law "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995). Trademark law likewise "'reduces the customer's costs of shopping and making purchasing decisions,'" by "assur[ing] a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past." *Id.* at 163-164 (brackets and citation omitted); see *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U.S. 203, 205 (1942) (describing a trademark as a "merchandising short-cut").

"Trademarks and their precursors have ancient origins, and trademarks were protected at common law and in equity at the time of the founding of our country." *Matal* v. *Tam*, 137 S. Ct. 1744, 1751 (2017); see *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). At common law, "[o]ne who first uses a distinct mark in commerce * * * acquires rights to that mark." *B & B Hardware*, 135 S. Ct. at 1299; see 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 3.02[2][a] (2014) (*Gilson*). Those rights allow the owner of the mark "to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his." *Prestonettes, Inc.* v. *Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.). The owner can enforce those rights "under state common law, or if [the mark] has been registered in a State, under that State's registration system." *Tam*, 137 S. Ct. at 1753.

"Though federal law does not create trademarks, Congress has long played a role in protecting them." *B & B Hardware*, 135 S. Ct. at 1299 (citation omitted);

see, *e.g.*, Act of Feb. 20, 1905 (1905 Act), ch. 592, 33 Stat. 724; Act of July 8, 1870, ch. 230, §§ 77-84, 16 Stat. 210-212. In 1946, Congress enacted the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), "the current federal trademark scheme," *B & B Hardware*, 135 S. Ct. at 1299. Under the Lanham Act, the owner of a mark used in interstate or foreign commerce, whether registered or not, may sue for trademark infringement "in federal court if another is using a mark that too closely resembles the plaintiff's." *Id.* at 1301; see 15 U.S.C. 1114(1)(a) (federally registered marks); 15 U.S.C. 1125(a) (federally unregistered marks); see also *Tam*, 137 S. Ct. at 1752 (explaining that, "even if a trademark is not federally registered, it may still be enforceable under [Section 1125(a)]"). Certain federal remedies for dilution and unfair competition are likewise available to owners of marks used in commerce, regardless of whether the mark is registered. See 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(c) (remedy for dilution of famous marks); 15 U.S.C. 1125(d) (remedy for cybersquatting).

The Lanham Act confers additional benefits on owners who federally register their marks. See *Tam*, 137 S. Ct. at 1753; 3 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 19:9 (5th ed. 2018). For example, registration serves as nationwide "constructive notice of the registrant's claim of ownership" of the mark, 15 U.S.C. 1072, which forecloses certain defenses in infringement actions, see 1 *Gilson* § 4.02. It also is "prima facie evidence of the validity of the registered mark * * * and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration." 15 U.S.C. 1115(a); see 15 U.S.C. 1057(b). In addition, after five years of registration, the owner's right to use

a trademark can become "incontestable," so that it may be challenged only on limited grounds. 15 U.S.C. 1065, 1115(b); see, *e.g.*, *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 205 (1985) (holding that, after the owner's right to use the mark becomes incontestable, the mark cannot be challenged on the ground that it is "merely descriptive").

To obtain the benefits of registration, an "owner of a trademark used in commerce" applies to the USPTO to record the mark on the agency's "principal register." 15 U.S.C. 1051(a)(1); see 35 U.S.C. 2(a)(1). The application must include a description of "the goods in connection with which the mark is used." 15 U.S.C. 1051(a)(2). If the USPTO grants the application, it issues the owner of the trademark a certificate of registration "in the name of the United States of America," 15 U.S.C. 1057(a), and the owner "may give notice that his mark is registered by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®," 15 U.S.C. 1111.

Only marks that satisfy the statutory criteria can be registered. Congress has directed the USPTO to "refuse[] registration" of, among others, marks that are deceptive, 15 U.S.C. 1052(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks that include a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e)(1); and marks that are functional, 15 U.S.C. 1052(e)(5).

This case concerns a Lanham Act provision that directs the USPTO to refuse registration of marks consisting of or comprising "immoral" or "scandalous" matter. 15 U.S.C. 1052(a). Such a provision has been a feature of federal trademark-registration programs since 1905. See 1905 Act § 5, 33 Stat. 725. Although the Lanham Act precludes registration of "scandalous" and "immoral" marks, the USPTO has long treated the two terms as composing a single category, and we accordingly refer to the prohibitions collectively as the "scandalous-marks" provision. See *In re McGinley*, 660 F.2d 481, 484 n.6 (C.C.P.A. 1981) ("not[ing] the dearth of reported trademark decisions in which the term 'immoral' has been directly applied").

To determine whether the scandalous-marks provision applies to a particular mark, the USPTO asks whether a "'substantial composite of the general public' would find the mark scandalous." Pet. App. 3a (citation omitted). The agency generally defines "scandalous" as "'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . or calling out for condemnation.'" *Ibid.* (citation omitted). The agency understands, and the Federal Circuit has held, that the term includes "[v]ulgar" marks, *i.e.*, those "'lacking in taste, indelicate, [and] morally crude.'" *Ibid.* (citation omitted; second set of brackets in original). Over the years, the USPTO has invoked this provision as a basis for refusing to register a variety of vulgar and lewd marks. See Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017) (providing a sample of particularly vulgar marks, including depictions of individuals engaged in sexual activity, for which the USPTO has refused registration).

2. This case arises from the USPTO's refusal of respondent Erik Brunetti's application to register the mark "FUCT" for a clothing line that includes children's and infants' apparel. Pet. App. 55a. Respondent has used the mark in connection with his clothing line since 1991. C.A. App. A52. In 2011, the USPTO received an application for federal registration of the mark. Pet. App. 4a. A USPTO examining attorney refused registration under Section 1052(a) based on evidence that the mark consisted of "scandalous" matter. See J.A. 19, 26.

The USPTO's Trademark Trial and Appeal Board (Board) affirmed. Pet. App. 55a-67a. The Board observed that "the term 'fuct' is recognized as a slang and literal equivalent" of the word for which it is a homonym, *id.* at 61a, and that respondent used the mark in connection with apparel and promotional material displaying "strong, and often explicit, sexual imagery," *id.* at 63a. Based on that evidence, the Board found that the mark as used by respondent would "be perceived by his targeted market segment" as the profane word for which it is a homonym. *Id.* at 64a. The Board concluded on that basis that the mark was vulgar and therefore unregistrable under 15 U.S.C. 1052(a). Pet. App. 67a. Although respondent argued that the scandalous-marks provision violated the First Amendment, the Board found the resolution of that constitutional question to be beyond its statutory authority. *Ibid.*

3. a. Respondent sought review of the Board's decision in the Federal Circuit. While the case was pending in the court of appeals, this Court issued its decision in *Matal* v. *Tam*, *supra*, concerning the constitutionality of Section 1052(a)'s separate ban on federal registration of "disparag[ing]" trademarks, 15 U.S.C. 1052(a). All

eight Justices who participated in *Tam* agreed that the disparagement provision discriminated based on the speaker's viewpoint, and that the provision was facially invalid under the First Amendment. See 137 S. Ct. at 1763, 1765 (Alito, J.); *id.* at 1766-1769 (Kennedy, J.).

b. After supplemental briefing and reargument in light of *Tam*, the court of appeals reversed the Board's decision in this case. Pet. App. 1a-46a. The court first upheld the Board's determination that respondent's mark is "scandalous" under Section 1052(a). *Id.* at 6a-10a. The court held that substantial evidence supported the Board's findings that respondent's mark is a "'phonetic twin'" of a vulgar term, and that a "'substantial composite' of the American public would find the mark vulgar." *Id.* at 6a-7a, 9a (citation omitted). The court further held that, given those findings, federal registration of the mark was barred by Section 1052(a)'s scandalous-marks provision. *Id.* at 9a-10a.

The court of appeals concluded, however, that Section 1052(a)'s scandalous-marks provision is facially invalid under the First Amendment. Pet. App. 11a-46a. While assuming *arguendo* that the provision is viewpoint-neutral, the court held that "the provision impermissibly discriminates based on content in violation of the First Amendment." *Id.* at 14a. In reaching that conclusion, the court began from the premise that content discrimination of any kind is subject to strict scrutiny unless some alternative First Amendment framework applies. *Id.* at 15a. The court then rejected each of the government's arguments that the statutory criteria for obtaining the benefits of federal trademark registration should not receive the same First Amendment scrutiny that applies to a content-based restriction on speech.

The court of appeals rejected the government's argument that the trademark-registration program should be analyzed as a government subsidy for marks that the government wishes to promote, rather than as a restriction on speech. Pet. App. 16a-22a. The court distinguished prior decisions recognizing Congress's broad authority to define the scope of government programs, *e.g.*, *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983), on the ground that "[t]rademark registration does not implicate Congress' power to spend funds." Pet. App. 19a. The court concluded that the constitutional principles applicable to government subsidies apply only to Spending Clause legislation, and that the trademark-registration program is not a Spending Clause program. *Id.* at 21a-22a. The court also distinguished precedents related to limited public (or nonpublic) forums, *id.* at 22a-28a, concluding that limited-public-forum principles apply only when the government excludes speech from its own property, *id.* at 25a.

Having rejected the subsidy and limited-public-forum frameworks, the court of appeals analyzed the scandalous-marks provision as a direct restriction on speech. The court concluded that the ban on registering scandalous marks regulates speech based on its expressive (and not just commercial) content; that it is not related to the trademark-registration program's commercial purpose of facilitating source identification; and that it is therefore subject to strict scrutiny. Pet. App. 29a-31a. Noting that the government had not suggested that the provision could survive strict scrutiny, the court concluded that the scandalous-marks provision is facially invalid. *Id.* at 31a.

In the alternative, the court of appeals held that the scandalous-marks provision could not survive scrutiny under the First Amendment standards that apply to regulation of commercial speech. Pet. App. 31a-42a; see *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 566 (1980) (explaining that First Amendment analysis of restrictions on commercial speech turns on whether (1) the speech being regulated concerns lawful activity and is not misleading; (2) the asserted government interest is substantial; (3) the regulation directly advances that government interest; and (4) the regulation is "more extensive than is necessary to serve that interest"). The court concluded that the government has no legitimate substantial interest in declining to encourage graphic sexual images as source identifiers in commerce, because registration does not associate the government with those marks and because speech cannot be suppressed merely because it will be off-putting to others. Pet. App. 32a-38a. The court further held that, even if the government interest in "protecting the public" from such marks were viewed as legitimate, refusing to register those marks would not "directly advance" the government's interest because it would not "directly prevent applicants from using their marks." *Id.* at 38a. The court further found that the refusal to register scandalous marks under Section 1052(a) is not sufficiently tailored to the government's interest because, in the court's view, there is no clear standard for determining which marks are "scandalous" and the USPTO has applied the provision inconsistently in the past. *Id.* at 39a-41a.

c. Judge Dyk concurred in the judgment. Pet. App. 47a-54a. He "agree[d] with the majority" that this

Court's decision in *Tam* "does not dictate the facial invalidity of the immoral-scandalous provision." *Id.* at 47a. Rather than resolve the "serious First Amendment questions" left open in *Tam*, however, Judge Dyk would have avoided those issues by construing the scandalous-marks provision to reach only obscene material that is unprotected by the First Amendment. *Id.* at 48a. Judge Dyk concluded that respondent would prevail under that construction "[b]ecause there is no suggestion that [respondent's] mark is obscene." *Id.* at 54a.

4. The court of appeals denied the government's petition for rehearing en banc without noted dissent. Pet. App. 68a-69a.

SUMMARY OF ARGUMENT

The scandalous-marks provision in 15 U.S.C. 1052(a) is facially constitutional under the Free Speech Clause of the First Amendment.

A. This case presents an issue that the Court's decision in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), did not address. In *Tam*, the Court struck down, as a violation of the Free Speech Clause, a provision of Section 1052(a) that directed the USPTO to refuse to register "disparag[ing]" marks. 15 U.S.C. 1052(a). Although most of the Court's First Amendment analysis was split between two opinions, neither of which secured a majority, all eight Justices who participated in *Tam* agreed that the disparagement provision discriminated on the basis of viewpoint. That unanimous agreement made it unnecessary to address in detail the First Amendment analysis that should apply to federal-registration criteria that are viewpoint-neutral. Because the scandalous-marks provision at issue here is viewpoint-neutral, the decision in *Tam* sheds little light on the question presented in this case.

B. In declaring the scandalous-marks provision facially unconstitutional, the court of appeals subjected the provision to strict scrutiny. Strict scrutiny, however, is unwarranted here for three related reasons.

First, the scandalous-marks provision is not a restriction on speech. Rather, it is a condition on the availability of government benefits—namely, the benefits of federal trademark registration. This Court has recognized that the justification for strict scrutiny is generally absent when, as here, the government "does not restrict" speech, "but rather declines to promote" it. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009). *Second*, although the scandalous-marks provision turns on the content of the mark for which registration is sought, such content-based distinctions are an "inherent and inescapable" part of the federal trademark-registration program. *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 49 (1983). Application of strict scrutiny to such criteria would fundamentally disrupt the operation of that program. *Third*, the scandalous-marks provision is viewpoint-neutral. It bars registration of scandalous marks not because such marks are thought to convey offensive *ideas*, but because they reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.* v. *City of St. Paul*, 505 U.S. 377, 393 (1992).

C. As in other contexts where the government "does not restrict" speech "but rather declines to promote" it, *Ysursa*, 555 U.S. at 355, the Court should examine whether the statute is "reasonabl[y]" related to a legitimate government interest, *ibid.*, and whether it imposes an "unconstitutional condition" on the exercise of free speech, *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 214 (2013).

The scandalous-marks provision is a longstanding and reasonable means of vindicating a number of legitimate government interests. By creating a practical disincentive to the use of marks that contain sexually explicit or profane material, the provision advances the government's interest in encouraging the use of marks that are appropriate for all audiences, including children. By discouraging the use of marks that a substantial segment of the public would find shocking, the provision advances the government's interest in the orderly flow of commerce. And by withholding government benefits from such marks, the provision advances the government's interest in avoiding any appearance of government approval of them. The commercial character of trademark protection highlights the government's broader authority in the commercial sphere, and reinforces the conclusion that the scandalous-marks provision is constitutional.

The scandalous-marks provision also does not run afoul of this Court's unconstitutional-conditions doctrine. The USPTO's registrability analysis focuses solely on the trademark the applicant seeks to register, and a refusal to register the mark does not impose any adverse legal consequences outside the trademark-registration program.

D. In declaring the scandalous-marks provision facially unconstitutional, the court of appeals committed at least four important errors. *First*, the court erred in treating the provision as a restriction on speech rather than as a condition on the availability of government benefits. *Second*, the court erred in treating as irrelevant this Court's decisions involving government-established subsidies and forums. Those cases concerned similar limits on access to government support.

Third, the court of appeals erred in suggesting that the First Amendment analysis would necessarily be the same for a hypothetical statute that imposed content-based conditions on copyright registration. That suggestion overlooks fundamental differences between trademarks and copyrights and the legal regimes that protect them. *Fourth*, the court erred in relying on a concern that the scandalous-marks provision has been applied inconsistently. Any alleged inconsistencies in prior USPTO decisions provide no sound basis to conclude that the provision is incapable of principled application or facially invalid.

ARGUMENT

THE SCANDALOUS-MARKS PROVISION IN 15 U.S.C. 1052(a) IS FACIALLY CONSTITUTIONAL UNDER THE FIRST AMENDMENT

The court of appeals erred in applying strict scrutiny to Section 1052(a)'s scandalous-marks provision, and in holding that the statutory ban on federal registration of scandalous trademarks violates the First Amendment. The scandalous-marks provision does not prohibit any speech, proscribe any conduct, or restrict the use of any trademark. Rather, it simply directs the USPTO to refuse, on a viewpoint-neutral basis, to provide the benefits of federal registration to scandalous marks. In a variety of contexts, this Court has recognized that Congress has substantial latitude to treat the content of speech as a criterion for government-conferred benefits.

The court of appeals' application of strict scrutiny was particularly misguided given the nature of the Lanham Act's trademark-registration program. In determining whether particular marks are eligible for registration, the USPTO necessarily must consider the content of the marks. Section 1052(a)'s scandalous-marks

provision is simply one of many content-based registration bans—on merely descriptive marks, and functional marks, and marks that contain a national symbol, and so on—which generally have not been thought to raise constitutional concerns. Application of strict scrutiny to laws that ban federal registration of particular types of marks would fundamentally disrupt the registration program.

This Court's decision in *Matal* v. *Tam*, 137 S. Ct. 1744 (2017), does not support the court of appeals' approach. The Court in *Tam* held that Section 1052(a)'s ban on registration of "disparag[ing]" marks violates the First Amendment. *Id.* at 1751 (quoting 15 U.S.C. 1052(a)). The only rationale on which a majority of the Court agreed, however, was that the "disparage[ment]" provision discriminated on the basis of *viewpoint*. That determination largely resolved the case, since the government's authority to engage in viewpoint discrimination is highly circumscribed, even in programs that the government itself has created. The *Tam* Court's invalidation of a viewpoint-*discriminatory* trademark-registration ban sheds little light on the proper First Amendment analysis of a viewpoint-*neutral* registration criterion like the one at issue here.

A. This Court's Decision In *Tam* Is Limited To Trademark-Registration Criteria That Discriminate Based On Viewpoint

In *Tam*, this Court declared unconstitutional Section 1052(a)'s directive that the USPTO refuse registration of "disparag[ing]" marks. 137 S. Ct. at 1751 (quoting 15 U.S.C. 1052(a)). The statutory language at issue in *Tam* prohibits the USPTO from registering a trademark that contains "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national

symbols, or bring them into contempt, or disrepute." 15 U.S.C. 1052(a). The Court in *Tam* held that the disparagement provision violates the Free Speech Clause of the First Amendment. 137 S. Ct. at 1751. The only rationale that commanded a majority of the Court, however, was that the disparagement provision discriminated on the basis of viewpoint. Because the scandalous-marks provision at issue here is viewpoint-neutral (see pp. 26-30, *infra*), the decision in *Tam* sheds little light on its First Amendment status.

1. Writing for all eight Justices who participated in *Tam*, Justice Alito concluded that the trademark-registration program is not government speech. 137 S. Ct. at 1757-1760. The rest of Justice Alito's First Amendment analysis, however, did not garner a majority of the Court. Writing for four Justices, Justice Alito rejected the government's argument that "th[e] case [wa]s governed by cases in which this Court has upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint." *Id.* at 1760; see *id.* at 1760-1761. He further concluded that the disparagement provision discriminates based on viewpoint and therefore could not be sustained as a permissible limitation on a government program or limited public forum. *Id.* at 1762-1763. Finally, Justice Alito assumed without deciding that such a viewpoint-based condition on trademark registration should be analyzed under the standard applicable to restrictions on commercial speech, and he concluded that the disparagement provision could not be sustained because it was not sufficiently tailored to a substantial government interest. *Id.* at 1763-1765.[1]

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[1] Although Justice Thomas joined Justice Alito's First Amendment analysis in full, he also filed a short concurrence expressing

2. Writing on behalf of the four remaining Justices, Justice Kennedy concurred on narrower grounds. See *Tam*, 137 S. Ct. at 1765. Those Justices agreed that the disparagement provision "constitutes viewpoint discrimination." *Ibid.* Unlike their colleagues, however, they did not address the government's arguments that the disparagement provision should be analyzed as a limitation on a government program or subsidy. See *ibid.* Rather, they explained that "the Court's precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf." *Id.* at 1768. They concluded that, because the disparagement provision does not fall within that narrow exception, *id.* at 1768-1789, "the viewpoint discrimination rationale render[ed] unnecessary any extended treatment of other questions raised by the parties," *id.* at 1765, such as "whether trademark registration should be considered a federal subsidy," *id.* at 1767.

3. All eight Justices who participated in *Tam* thus agreed on the viewpoint-discriminatory character of the disparagement provision. 137 S. Ct. at 1763 (Alito, J.); *id.* at 1765 (Kennedy, J.). This Court has described viewpoint discrimination as "an egregious form of content discrimination," *Rosenberger* v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995), that is subject to particularly stringent First Amendment constraints. The Court's limited-public-forum decisions, for example, establish a "framework forbidding the State to exercise viewpoint discrimination, even when the limited

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the view that the disparagement provision should be subject to strict scrutiny even if trademarks are commercial speech. *Tam*, 137 S. Ct. at 1769.

public forum is one of its own creation." *Ibid.*; cf. *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 587 (1998) ("[E]ven in the provision of subsidies, the Government may not 'aim at the suppression of dangerous ideas.'") (brackets and citation omitted).

The *Tam* Justices' unanimous agreement that the disparagement provision discriminated based on viewpoint made it unnecessary to delineate in detail the First Amendment analysis that should apply to Lanham Act provisions that do not share that vice. And while the two principal opinions differed in other respects, they both reserved judgment on the appropriate framework for evaluating the constitutionality of viewpoint-neutral criteria for federal trademark registration. See *Tam*, 137 S. Ct. at 1763 & n.16 (Alito, J.) ("leav[ing] open" the question whether viewpoint-neutral criteria could be "saved" by analyzing federal registration as a "type of government program in which some content- and speaker-based restrictions are permitted"); *id.* at 1768 (Kennedy, J.) (leaving open "the question of how other provisions of the Lanham Act should be analyzed under the First Amendment").

As we explain below (see pp. 26-30, *infra*), Section 1052(a)'s ban on registration of scandalous marks is a viewpoint-neutral provision. This case therefore squarely presents the question that the Court in *Tam* left unresolved. Because the scandalous-marks provision establishes a reasonable condition for participation in a federal program that inherently requires content-based distinctions, it is consistent with the First Amendment.

B. Because The Scandalous-Marks Provision Is A Viewpoint-Neutral Condition On A Government Benefit Whose Availability Necessarily Turns On The Content Of An Applicant's Speech, The Court Of Appeals Erred In Subjecting That Provision To Strict Scrutiny

As a general matter, when the government *restricts* speech on the basis of content, such regulation "may be justified only if the government proves that [it is] narrowly tailored to serve compelling state interests." *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015). This Court, however, has "identified numerous situations" involving "'content discrimination'" in which "strict scrutiny is unwarranted"—including situations in which "the government is acting in a capacity other than as regulator." *Davenport* v. *Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007). In this case, the USPTO's determination that respondent's mark was "scandalous" and therefore unregistrable undoubtedly turned on the content of the mark. For three related reasons, however, strict scrutiny is unwarranted here.

First, Section 1052(a)'s scandalous-marks provision is not a restriction on speech. That provision does not limit respondent's ability to use "FUCT," whether as a mark or otherwise, on his clothing line, in advertisements, or anywhere else. Rather, the sole effect of Section 1052(a)'s scandalous-marks provision is to deny respondent the benefits of federal trademark registration. *Second*, consideration of a mark's content is an inherent and essential feature of the Lanham Act's (or, indeed, any) trademark-registration program, and the scandalous-marks provision is only one of a number of registrability criteria that turn on the content of an applicant's mark. To treat the denial of registration as the

constitutional equivalent of a ban on speech, and to apply strict scrutiny to content-based criteria for trademark registration under the Lanham Act, would fundamentally disrupt the statutory scheme. *Third*, "scandalous" marks are ineligible for registration not because they are thought to convey offensive *ideas*, but because such marks reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.* v. *City of St. Paul*, 505 U.S. 377, 393 (1992). The scandalous-marks provision thus differs from the disparagement provision struck down in *Tam*, which the Court viewed as targeting the underlying "ideas" expressed. 137 S. Ct. at 1751 (Alito, J.); see *id.* at 1766 (Kennedy, J.).

1. The scandalous-marks provision does not restrict speech, but simply imposes a condition on the availability of a government benefit

a. Since 1905, Congress has promoted commerce and consumer welfare through a voluntary nationwide trademark-registration system. See *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation."). In recognition of the important commercial functions that trademarks serve, Congress committed the resources of the federal government to examining, registering, and publishing—and thereby furthering the protection of—marks that meet specified criteria.

Trademark rights arise through use of the mark to identify goods and services in commerce, without regard to federal law. See *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015) (explaining

that "federal law does not create trademarks"; rather, a person who "first uses a distinct mark in commerce * * * acquires rights to that mark"); see also *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Rather than modify or displace common-law trademark rights, the Lanham Act supplements those rights by creating statutory rights and remedies that are available to all trademark owners. See 15 U.S.C. 1116-1118, 1125(a)-(d). It also provides additional benefits to the owners of federally registered marks. Those additional benefits are directly traceable to resources devoted by the federal government to the examination and publication of qualifying marks.

For example, because registered marks have withstood examination by the USPTO, registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with certain goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). Federal examination likewise provides an objective basis for U.S. Customs and Border Protection officers to take unilateral steps to exclude counterfeit goods from importation—an exclusion that is itself accomplished through a separate use of federal resources. 15 U.S.C. 1124. And because the USPTO publishes registered marks on its principal register, registration provides nationwide constructive notice of the registrant's claim of ownership of the mark, which creates a disincentive for others to use the mark even in areas in the United States that are geographically remote from the one where the mark has already been used. 15 U.S.C. 1072. This constructive notice also provides the justification for making the owner's right to use a federally registered mark largely "incontestable" after a period of time, 15 U.S.C. 1065, 1115(b), thereby allowing owners

to "quiet title" in their marks, *Park 'N Fly*, 469 U.S. at 198.

b. As an eligibility criterion for the commercial advantages described above, the scandalous-marks provision is fundamentally different from a restriction on speech. In a variety of contexts, the government uses content-based criteria not to determine whether particular private speech should be *prohibited*, but to allocate various government *benefits*. See *Christian Legal Soc'y Chapter of the Univ. of Cal., Hastings Coll. of the Law* v. *Martinez*, 561 U.S. 661, 687 n.17 (2010) (emphasizing the "distinction between state *prohibition* and state *support*"); *Maher* v. *Roe*, 432 U.S. 464, 475 (1977) ("There is a basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy.").

The demanding standard of review that applies to *restrictions* on speech is often inappropriate in these contexts. That conclusion follows from the First Amendment's text, which "prohibits government from 'abridging the freedom of speech'" but "does not confer an affirmative right" to government assistance in speaking. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009) (quoting U.S. Const. Amend. I). It also reflects the recognition that "[t]he risk that content-based distinctions will impermissibly interfere with the marketplace of ideas is sometimes attenuated when the government is acting in a capacity other than as regulator." *Davenport*, 551 U.S. at 188. When the government "does not restrict" speech, "but rather declines to promote" it, *Ysursa*, 555 U.S. at 355, the justification for strict scrutiny is generally absent, see *id.* at 359, and the Court has instead applied a "less restrictive level of scrutiny," *Christian Legal Soc'y*, 561 U.S. at 680; see,

e.g., *Ysursa*, 555 U.S. at 359; *Cornelius* v. *NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 799-800 (1985); *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546-551 (1983).

For example, "it is well established that the government can make content-based distinctions when it subsidizes speech." *Davenport*, 551 U.S. at 188-189. The government thus can select what speech it wishes to facilitate and encourage by imposing content-based conditions on the receipt of federal funding. *Regan*, 461 U.S. at 548. Rejecting the "suggest[ion] that strict scrutiny applies whenever Congress subsidizes some speech, but not all speech," *ibid.*, the Court has instead required that funding conditions be reasonable, see *Rust* v. *Sullivan*, 500 U.S. 173, 197 (1991); *Regan*, 461 U.S. at 550-551; *Ysursa*, 555 U.S. at 359-360, and that they not "reach outside" the federal program, *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 570 U.S. 205, 217 (2013).

c. The scandalous-marks provision does not restrict speech. "[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question." *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). On the contrary, the owner may continue using its mark—and any other vulgar term or image it wishes—to identify its goods in commerce. See *Tam*, 137 S. Ct. at 1752 ("Without federal registration, a valid trademark may still be used in commerce."). Respondent has been using the mark "FUCT" since 1991, see C.A. App. A52, and the USPTO's refusal to register the mark does not disturb that status quo.

The USPTO's refusal to register a mark likewise does not prevent a mark owner from enforcing its mark

against others. The federal registration program presupposes the existence of a protectable trademark interest, see, *e.g.*, 15 U.S.C. 1051(a)(1) (providing that "[t]he owner of a trademark used in commerce may request registration of its trademark on the principal register"), and the owner of an unregistered mark may still assert whatever common-law or state-law rights he may have, see *Tam*, 137 S. Ct. at 1753. The owner may also invoke the Lanham Act's federal cause of action against misappropriation and consumer confusion, 15 U.S.C. 1125(a)(1), as well as other federal statutory protections and remedies, see 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(c) (remedy for dilution of famous marks even in the absence of likelihood of confusion); 15 U.S.C. 1125(d) (remedy for cybersquatting); 15 U.S.C. 1117(a) (disgorgement of profits, damages (with potential trebling), and attorney's fees (in exceptional cases) for infringement, cybersquatting, and willful dilution of marks).

The only consequence of a USPTO determination that a particular mark is "scandalous" is the unavailability of additional benefits associated with federal registration. To be sure, the prospect of obtaining those benefits may, as a practical matter, result in "indirect pressure" to use an alternative mark that is not vulgar or otherwise ineligible for registration. *Christian Legal Soc'y*, 561 U.S. at 682. But this Court has declined to equate such pressure with "direct restrictions on expression" warranting strict scrutiny. *Ysursa*, 555 U.S. at 360 n.2; see *ibid.* ("A decision not to assist fundraising that may, as a practical matter, result in fewer contributions is simply not the same as directly limiting expression."); *Christian Legal Soc'y*, 561 U.S. at 683 (distinguishing "dangling the carrot of subsidy" from "wielding the stick of prohibition"); *Rust*, 500 U.S. at

193 ("A refusal to fund protected activity, without more, cannot be equated with the imposition of a 'penalty' on that activity.") (citation omitted).

2. Administration of the federal trademark-registration program inherently and necessarily requires the government to draw distinctions based on the content of applicants' marks

Strict scrutiny is particularly unjustified in this context because content-based distinctions are an "inherent and inescapable" part of the Lanham Act's trademark-registration program. *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 49 (1983). The scandalous-marks provision is only one of a number of Lanham Act registration criteria that turn on the content of the mark for which registration is sought. Section 1052 directs the USPTO to "refuse[] registration" of, *inter alia*, marks that are deceptive, 15 U.S.C. 1052(a); marks that contain a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks that include a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e)(1); and marks that are functional, 15 U.S.C. 1052(e)(5). The federal trademark-registration program has included those types of content-based criteria for more than one hundred years. See 1905 Act § 5, 33 Stat. 725-726.

Although those prerequisites to trademark registration are content-based, they have not historically been viewed as raising meaningful First Amendment concerns. See *Tam*, 137 S. Ct. at 1768 (Kennedy, J.) ("It is well settled, for instance, that to the extent a trademark

is confusing or misleading the law can protect consumers and trademark owners."). Indeed, the determination whether a proposed mark adequately serves the purpose of identifying goods or services in commerce, and is not otherwise deceptive or misleading, necessarily turns at least in part on the mark's content. Application of strict scrutiny to those provisions would fundamentally disrupt the operation of the federal registration program.

To be sure, other Lanham Act criteria on trademark registrability may serve public and government interests that differ in some respects from those that the scandalous-marks provision is intended to vindicate. Because an appropriate First Amendment analysis requires consideration both of the government and public interests that a particular registration criterion serves, and of the burdens on the mark owner that the provision entails, those various criteria will not necessarily stand or fall together. There is no sound reason, however, that the Lanham Act's different content-based but viewpoint-neutral criteria on registrability should be subjected to different levels of First Amendment scrutiny.

3. The scandalous-marks provision is viewpoint-neutral

a. The scandalous-marks provision directs the USPTO to refuse to register trademarks containing "immoral * * * or scandalous matter." 15 U.S.C. 1052(a). Although "what constitutes 'immoral . . . or scandalous matter' has evolved over time," "[t]he formal legal framework * * * has remained consistent." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) (citation omitted). Courts have long construed "scandalous" to mean, among other things, "shocking to the sense of propriety." *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938); see *In re McGinley*, 660 F.2d 481, 485-486 (C.C.P.A. 1981). And

in applying that definition, the USPTO has long refused to register marks that would be considered "[v]ulgar." *In re Runsdorf*, 171 U.S.P.Q. 443, 444 (T.T.A.B. 1971); see *Boulevard Entm't*, 334 F.3d at 1340 ("A showing that a mark is vulgar is sufficient to establish that it 'consists of or comprises immoral . . . or scandalous matter' within the meaning of section 1052(a).").

The quintessential vulgar mark is one that contains sexually explicit or profane material. See, *e.g.*, *Fox*, 702 F.3d at 637 n.1 (refusal to register a slang reference to a sexual organ and activity); *Boulevard Entm't*, 334 F.3d at 1338 (refusal to register a "reference to masturbation"); *McGinley*, 660 F.2d at 482 (refusal to register a "photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia"). A sample of such "highly offensive, even shocking, images and words for which individuals have sought trademark registration" appears in the addendum to the government's supplemental brief in the court of appeals. Pet. App. 45a; see Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017).

When the USPTO refuses to register such marks under the scandalous-marks provision, it does so not because "their content communicates any particular idea," but because those marks reflect an offensive "*mode* of expressing *whatever* idea the speaker wishes to convey." *R. A. V.*, 505 U.S. at 393. In this case, for instance, the USPTO refused to register the term "FUCT" because that term is the "phonetic twin" of a "vulgar" and "extremely offensive" word. Pet. App. 65a. The applicability of the scandalous-marks provision did not turn on what (if any) message respondent sought to convey by using that term. The agency's refusal to register the mark was based not on the views expressed, but on

the "especially offensive mode of expression." *R. A. V.*, 505 U.S. at 393.

b. This Court's decisions support the conclusion that the scandalous-marks provision is viewpoint-neutral. This Court has long denied First Amendment protection to obscenity. See *Miller* v. *California*, 413 U.S. 15, 24 (1973). And while "the threshold for objectionable matter is lower for what can be described as 'scandalous' than for 'obscene,'" *McGinley*, 660 F.2d at 485 n.9, vulgar words and images "offend for the same reasons that obscenity offends," *FCC* v. *Pacifica Found.*, 438 U.S. 726, 746 (1978) (plurality opinion)—namely, "because their content is so offensive to contemporary moral standards," *id.* at 745; see *id.* at 746 n.23.

This Court has long regarded that rationale for speech-related regulation as viewpoint-neutral. In *Pacifica*, for example, the Court rejected a First Amendment challenge to the government's exercise of regulatory power to "restrict the public broadcast of indecent language." 438 U.S. at 744 (plurality opinion). The language at issue was that of a George Carlin monologue, which consisted of "patently offensive words dealing with sex and excretion," *id.* at 745. The plurality acknowledged that "it is a central tenet of the First Amendment that the government must remain neutral in the marketplace of ideas." *Id.* at 745-746. The plurality explained, however, that "[v]erbal or physical acts exposing [certain private bodily functions] are offensive irrespective of any message that may accompany the exposure." *Id.* at 746 n.23. The plurality therefore concluded that, in objecting to the monologue, the government had objected "not to [a] point of view, but to the way in which it [wa]s expressed." *Id.* at 746 n.22.

The Court reached a similar conclusion in *Bethel School District No. 403* v. *Fraser*, 478 U.S. 675 (1986). In that case, a school district had disciplined a student for giving an "offensively lewd and indecent speech" at a school assembly. *Id.* at 685. In rejecting a First Amendment challenge to the school district's decision, the Court found the sanctions imposed to be "unrelated to any political viewpoint." *Ibid.* The Court thus distinguished any such viewpoint from the student's "offensive form of expression," suggesting that regulation of the latter was viewpoint-neutral. *Id.* at 682.

Contrary to respondent's suggestion (Br. in Opp. 11-12), the Court did not reject such a distinction in *Cohen* v. *California*, 403 U.S. 15 (1971). The Court in that case concluded that the defendant's conviction rested on "the asserted offensiveness of the *words* [the defendant] used to convey his message to the public." *Id.* at 18. But the Court did not treat the differential treatment of those words as discrimination on the basis of viewpoint. Rather, it described the defendant's language as a "distasteful mode of expression." *Id.* at 21. While recognizing that the vulgarity of the defendant's expression might have contributed to the "emotive" force of the "ideas" he had conveyed, the Court distinguished that "emotive" element from the substance of the "ideas" themselves. *Id.* at 26; see *id.* at 19 (distinguishing regulation of the "manner" of speech from regulation of "the substantive message it conveys"); *Bethel*, 478 U.S. at 682 (distinguishing the defendant's "antidraft viewpoint" in *Cohen* from the "offensive form of expression" he used). The Court's reasoning in *Cohen* therefore supports the conclusion that the scandalous-marks provision is viewpoint-neutral. See *Perry* v. *McDonald*, 280 F.3d 159, 170 (2d Cir. 2001) (treating a prohibition

on the use of "scatological" terms as viewpoint-neutral); *PMG Int'l Div., L.L.C.* v. *Rumsfeld*, 303 F.3d 1163, 1171 (9th Cir. 2002) (treating a prohibition on "sexually explicit materials" as viewpoint-neutral); *General Media Commc'ns, Inc.* v. *Cohen*, 131 F.3d 273, 276 (2d Cir. 1997) (same), cert. denied, 524 U.S. 951 (1998).

c. A contrary conclusion would have potentially far-reaching implications. Governments commonly exclude sexually explicit images, lewd pictures, and profanity from limited public (or nonpublic) forums. A city government might decide, for instance, that graphic sexual imagery should not appear on advertisements on city buses and billboards. See, *e.g.*, *American Freedom Def. Initiative* v. *Washington Metro. Area Transit Auth.*, 901 F.3d 356, 364 (D.C. Cir. 2018) (treating advertising space on the Metro as a nonpublic forum), petition for cert. pending, No. 18-1000 (filed Jan. 28, 2019). Or the federal government might similarly exclude such expression from a military cemetery. See, *e.g.*, *Griffin* v. *Department of Veterans Affairs*, 274 F.3d 818, 820 (4th Cir. 2001), cert. denied, 537 U.S. 947 (2002).

Viewpoint discrimination, however, is impermissible even within a forum or other program that the government itself has created. See *Tam*, 137 S. Ct. at 1763 (Alito, J.); *id.* at 1768 (Kennedy, J.); *Rosenberger*, 515 U.S. at 830. Treating Section 1052(a)'s scandalous-marks provision as viewpoint-discriminatory therefore would have potential consequences extending well beyond the trademark-registration program. If targeting vulgar material were considered a form of viewpoint discrimination, the constitutionality of reasonable limits like those described above, and similar exclusions of lewd or vulgar speech from other government-sponsored activities, would be called into doubt.

C. The Scandalous-Marks Provision Is Reasonably Related To Legitimate Government Interests And Does Not Reach Outside The Federal Trademark-Registration Program

As in other contexts where the government "does not restrict" speech "but rather declines to promote" it, the appropriate First Amendment inquiry examines whether the statute is "reasonabl[y]" related to a legitimate government interest. *Ysursa*, 555 U.S. at 355; see *Rosenberger*, 515 U.S. at 829; *Regan*, 461 U.S. at 546-551. The appropriate First Amendment inquiry also examines whether the statute imposes an "unconstitutional condition" on the exercise of free speech—here, by asking whether the scandalous-marks provision seeks to "leverage" the benefits of registration "to regulate speech outside the contours of the [trademark-registration] program itself." *Agency for Int'l Dev.*, 570 U.S. at 214-215.[2]

Though less demanding than strict scrutiny, these inquiries are not toothless. See *Agency for Int'l Dev.*, 570 U.S. at 217 (finding that a condition on funding to combat HIV/AIDS fell "on the unconstitutional side of the line"). Rather, they ensure that "Congress cannot recast a condition on [benefits] as a mere definition of its program" and thereby "reduce[]" the First Amendment inquiry to "a simple semantic exercise." *Id.* at 215 (citation omitted). At the same time, they leave Congress broad discretion to "encourage certain activities

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[2] These are the relevant inquiries under the Free Speech Clause. Other constitutional provisions afford additional protection against, for example, refusing registration on the basis of a suspect classification, such as race or national origin, see *Regan*, 461 U.S. at 546-547, or on the basis of the mark owner's religious identity or beliefs, see *Trinity Lutheran Church of Columbia, Inc.* v. *Comer*, 137 S. Ct. 2012, 2019 (2017).

it believes to be in the public interest." *Rust*, 500 U.S. at 193.

1. A ban on registration of scandalous marks is a longstanding and reasonable means of vindicating legitimate government interests

A ban on registration of scandalous marks has been a feature of federal trademark law for more than a century. See 1905 Act § 5, 33 Stat. 725. Nearly every State has enacted a similar provision. See Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 Trademark Rep. 1476, 1477 & n.3 (2011) (citing state statutes). And international treaties to which the United States is a party authorize member nations to impose such limits. See General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(3), 46 Stat. 2914, T.S. No. 833 (authorizing refusal to register marks "[w]hich offend public morals or which may be contrary to public order"); Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 (U.S. accession effective May 30, 1887) (similar); see also Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172, 1178-1179 (2013) (giving Canada, the United Kingdom, and Australia as examples of other countries that refuse to register marks that are either scandalous or contrary to public policy or morality). As the long history and pedigree of such provisions indicate, the scandalous-marks provision is reasonably related to legitimate government interests.

a. The statutory ban on registration of scandalous marks is reasonably related to the government's legitimate interest in protecting the sensibilities of the public. "[T]rademarks appear everywhere: they are openly

displayed in stores, presented on billboards and road signs, delivered to the mailbox, embedded in movies and television, [and] advertised throughout the internet." Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. Davis L. Rev. 2331, 2362 (2018); see Pet. App. 27a (noting "the breadth of goods and services" associated with scandalous marks, including "clothing, books, websites, beverages, mechanical contraptions, and live entertainment"). Indeed, that is the point of a trademark—"to appear in a way that is noticeable." Snow 2362 n.117.

Given the pervasive presence of trademarks in public view, Congress has a legitimate interest in encouraging the use of trademarks that are appropriate for all audiences, including children. See *McGinley*, 660 F.2d at 486 (observing that a trademark "may be used in a prominent location for public viewing by persons of all ages"); Snow 2362 n.117 ("Anywhere a child might perceive a commercial product, a child can perceive a scandalous mark."). Just as Congress may reasonably seek to limit the exposure of children to sexually explicit or profane material over the airwaves or in public libraries, see *United States* v. *American Library Ass'n*, 539 U.S. 194, 211-212 (2003) (plurality opinion); *Pacifica*, 438 U.S. at 748-750, it may reasonably decline to promote the commercial use of marks that contain similar material. Although refusing to register vulgar marks does not impose any legal constraint on use of such marks in commerce, it creates a practical disincentive to their use by rendering certain government benefits unavailable.

b. The refusal to register scandalous marks is also reasonably related to the government's legitimate in-

terest in the orderly flow of commerce. The "predominant function" of a trademark is to identify and distinguish the source of goods or services in commerce. *Wal-Mart Stores, Inc.* v. *Samara Bros.*, 529 U.S. 205, 212 (2000). By "quickly and easily" performing that "source-identifying" function, the most effective trademarks "'reduce the customer's costs of shopping and making purchasing decisions.'" *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 163-164 (1995) (brackets and citation omitted).

By definition, scandalous marks contain material that a "substantial composite of the general public" would find "'shocking to the sense of . . . propriety.'" *McGinley*, 660 F.2d at 485 (citation omitted). For much of the populace, seeing a scandalous mark in the marketplace thus is disruptive. See Pet. App. 46a (describing many of the scandalous marks for which the USPTO had refused registration as "lewd, crass, or even disturbing"); Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017) (providing a sample of highly offensive marks for which registration has been sought and refused). Such disruption disserves the purposes of trademarks and trademark law by making commercial transactions less efficient. See *Qualitex*, 514 U.S. at 163-164.

c. The refusal to register scandalous marks is also reasonably related to the government's legitimate interest in avoiding any appearance that the government approves of such marks. To be sure, "[t]rademarks are private, not government, speech." *Tam*, 137 S. Ct. at 1760. But the government has a legitimate interest in avoiding not just the "reality," but also the "appearance," of government approval of vulgar speech. *Ysursa*, 555 U.S. at 359. This Court has held, for example, that "limitations on speech may be justified by [an] interest

in 'avoiding the appearance of political favoritism.'" *Id.* at 360 (quoting *Cornelius*, 473 U.S. at 809). A similar interest justifies the refusal to register scandalous marks.

The government's association with a registered mark is an unavoidable facet of the trademark-registration program. The USPTO publishes registered marks in official government publications and records them on the agency's official register. See 15 U.S.C. 1051(a)(1), 1057(a), 1062, 1091; USPTO, *Trademark Official Gazette*, https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog. It also issues certificates of registration to mark owners "in the name of the United States," 15 U.S.C. 1057(a), and those certificates are transmitted to other countries and to the World Intellectual Property Organization to facilitate registration and enforcement abroad, see Paris Convention for the Protection of Industrial Property, Art. 6^{quinquies}, July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333; see also 15 U.S.C. 1141b (Madrid Protocol). Mark owners themselves may "give notice" that their marks are registered "by displaying with the mark the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.' or the letter R enclosed within a circle, thus ®." 15 U.S.C. 1111.

Although the government's association with a registered mark does not convert that mark into government speech, the public may still perceive that association as evidence of government approval—particularly when the ® symbol (or similar notation) appears next to the mark. And while Congress may be willing to tolerate that perception in most cases for the sake of maintaining a functional registration program, it may reasona-

bly draw the line at marks that contain material so offensive, irrespective of viewpoint, that a substantial segment of the population would find them shocking. See *McGinley*, 660 F.2d at 485; Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017). To avoid the appearance of government approval of such marks, the scandalous-marks provision sensibly prohibits their registration.

d. The commercial character of trademarks and trademark protection reinforces the conclusion that the scandalous-marks provision is constitutional. A trademark is inherently commercial in nature, since its "predominant function" is to identify a mark owner's company as the source of goods in commerce. *Wal-Mart Stores*, 529 U.S. at 212; see *Mishawaka Rubber & Woolen Mfg. Co.* v. *S. S. Kresge Co.*, 316 U.S. 203, 205 (1942) (describing a trademark as "a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants"). Even its "subsidiary functions"—to "invoke positive connotations in the consumer's mind," and to "attract an otherwise indifferent consumer's attention on a crowded store shelf," *Wal-Mart Stores*, 529 U.S. at 212—serve a commercial aim: "to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears," *Mishawaka Rubber*, 316 U.S. at 205; see *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (treating the use of the word "Olympic" as "commercial speech"); *Friedman* v. *Rogers*, 440 U.S. 1, 11 (1979) (treating the use of a trade name as "commercial speech" and observing that "the optometrist who uses a trade name 'does not wish to editorialize on any subject, cultural, philosophical, or political'") (citation omitted).

The benefits of trademark registration are likewise commercial. A trademark "does not confer a right to prohibit the use of [a] word or words" in all circumstances, but "only gives the right to prohibit the use of [them] so far as to protect the owner's good will against the sale of another's product as his." *Prestonettes, Inc.* v. *Coty*, 264 U.S. 359, 368 (1924) (Holmes, J.). Federal registration gives mark owners certain advantages in obtaining redress against infringers and other unauthorized users of the mark. See pp. 4-5, *supra*. Denial of registration renders those *commercial* advantages unavailable, but it does not impair the mark owner's ability to *use* the mark for any purpose.

In challenging the USPTO's refusal to register his mark, respondent therefore asserts a First Amendment right to receive substantial government assistance in suppressing his competitors' speech for the benefit of respondent's own commercial interests. In cases involving actual restrictions on commercial speech, this Court has recognized "the commonsense distinction between speech proposing a commercial transaction, *which occurs in an area traditionally subject to government regulation*, and other varieties of speech." *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557, 562 (1980) (emphasis added; citations and internal quotation marks omitted). The First Amendment scrutiny that applies to restrictions on commercial speech therefore reflects this Court's recognition of the greater flexibility that federal and state legislatures have to regulate in the commercial sphere. In assessing the constitutionality of Congress's refusal to confer on scandalous marks the benefits of federal registration, the Court should likewise give weight to the inherently commercial character of trademark protection, and to

the government's broader authority to encourage certain activities by commercial entities.

2. The scandalous-marks provision does not subject respondent or similarly situated persons to any adverse legal consequences outside the trademark-registration program

The scandalous-marks provision also does not run afoul of this Court's unconstitutional-conditions doctrine. That doctrine distinguishes between "conditions that define the federal program and those that reach outside it." *Agency for Int'l Dev.*, 570 U.S. at 217. Conditions of the latter type "can result in an unconstitutional burden on First Amendment rights," even in circumstances where the government had no constitutional obligation to create the program in question. *Id.* at 214.

The program at issue here is the federal trademark-registration program. Under that program, the USPTO's registrability analysis focuses solely on the trademark the applicant seeks to register. An applicant is not required, as a condition of registering a mark, to promise never to use vulgar terms, or to endorse the view that vulgar terms are unacceptable. Cf. *Agency for Int'l Dev.*, 570 U.S. at 218 (holding unconstitutional a condition on federal funding that went "beyond defining the limits of the federally funded program" "[b]y requiring recipients to profess a specific belief"). Respondent's use of the term "FUCT" on clothing and advertisements does not affect his right to register any *other* trademark (for the same or different products) that satisfies the statutory criteria.

The Lanham Act's ban on *registration* of scandalous marks also does not deprive respondent of rights he

would otherwise possess under other Lanham Act provisions or under state or common law. The statute makes certain benefits available to holders of *all* marks, including marks that have not been registered or that are ineligible for registration. The Act establishes a broad federal cause of action against misappropriation and consumer confusion, which can be invoked even in the absence of a valid or registered mark. 15 U.S.C. 1125(a)(1); see *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (explaining that Section 1125(a) "protects qualifying unregistered trademarks"). Congress has also prohibited the importation of goods bearing confusing markings without regard to federal registration. 15 U.S.C. 1125(b). It has provided federal protections against dilution of famous unregistered marks and cybersquatting on unregistered marks. 15 U.S.C. 1125(c)-(d). And it has permitted awards of disgorgement of profits, damages (with potential trebling), and attorney's fees (in exceptional cases) for infringement, cybersquatting, and willful dilution of unregistered trademarks. 15 U.S.C. 1117(a).

Thus, even without federal registration, respondent may use vulgar terms or symbols to identify his goods in commerce, and he has done so without federal interference since 1991. C.A. App. A52. He may also seek to enforce his rights against others who he believes have used the term in a way that would be likely to confuse consumers. See *Tam*, 137 S. Ct. at 1752. And despite the fact that his products feature profanity and nudity, see Pet. App. 7a, he may obtain for those goods the supplemental benefits that flow from federal trademark registration simply by selecting a mark that satisfies the statutory criteria. The fact that respondent cannot register the term "FUCT" as a trademark leaves him in the

same position he would have occupied if the federal trademark-registration program did not exist. Because the scandalous-marks provision "define[s] the federal program" and does not "reach outside it," *Agency for Int'l Dev.*, 570 U.S. at 217, it does not place "an unconstitutional burden on First Amendment rights," *id.* at 214.

D. The Court Of Appeals' Contrary Reasoning Is Erroneous

In reaching a contrary conclusion, the court of appeals committed at least four important errors.

1. The court of appeals erred in treating the scandalous-marks provision as a restriction on speech

If the USPTO determines that a particular mark is "scandalous" within the meaning of Section 1052(a), the only consequence is that the mark is refused registration. 15 U.S.C. 1052(a). Without federal registration, the mark "may still be used in commerce," *Tam*, 137 S. Ct. at 1752, as respondent's longstanding use of the term "FUCT" shows, see J.A. 38. Neither Section 1052(a) itself, nor the USPTO's determination that respondent's "FUCT" mark is scandalous, restricts respondent's ability to use the mark on goods or in advertisements, or to engage in any other associated speech.

Citing this Court's decision in *United States* v. *Playboy Entertainment Group, Inc.*, 529 U.S. 803, 812 (2000), the court of appeals found that strict scrutiny presumptively applies to any content-based discrimination "whether a government statute bans or merely burdens protected speech." Pet. App. 15a. But the "burdens" at issue in *Playboy* were still restrictions on speech. Although the provision struck down in that case did not impose a "complete prohibition" on sexually explicit television programming, its practical effect was to compel a substantial number of cable operators to

"silence[]" such programming "for two-thirds of the day in every home in a cable service area." 529 U.S. at 812. Section 1052(a), by contrast, does not silence respondent or restrict his ability to express himself, through use of his mark or otherwise, at any time or in any place. Rather, it denies him only the benefits associated with federal trademark registration.

2. The court of appeals erred in treating as irrelevant this Court's decisions involving government-established subsidies and forums

The court of appeals distinguished on their facts, and ultimately dismissed as irrelevant, various decisions of this Court applying First Amendment principles to subsidies and forums established by the government. Pet. App. 16a-28a; see pp. 20-26, *supra*. Those decisions, however, stand for the principle that strict scrutiny is generally unwarranted when the government "does not restrict" speech, "but rather declines to promote" it. *Ysursa*, 555 U.S. at 355; see *Davenport*, 551 U.S. at 188-189. Contrary to the court of appeals' suggestion (Pet. App. 16a-28a), that principle is not limited to circumstances involving the direct provision of government money or control over physical property.

For example, in *Davenport*, this Court applied that principle to a state statute that required public-sector unions to obtain a nonmember's affirmative consent before using that nonmember's agency-shop fees for election-related activities. 551 U.S. at 182. The statute thus drew "a distinction based on the content of speech: Specific consent was required from nonunion members before agency fees could be used for election-related activities, but consent was not required with respect to agency fees used for other purposes." *Ysursa*, 555 U.S. at 360 (citing *Davenport*, 551 U.S. at 181-182). The

Court rejected the unions' argument that this "modest limitation" on a government-conferred "benefit"—namely, the "extraordinary power" "to levy fees on government employees who do not wish to join the union"—violated the unions' First Amendment rights. *Davenport*, 551 U.S. at 184. In upholding that limitation, the Court "recognized that the statute, rather than suppressing union speech, simply declined to assist that speech by granting the unions the right to charge agency fees for election activities." *Ysursa*, 555 U.S. at 360; see *Davenport*, 551 U.S. at 189-190. The Court therefore found strict scrutiny to be unwarranted and upheld the statute as a "reasonable, viewpoint-neutral limitation" on a "state-bestowed entitlement." *Davenport*, 551 U.S. at 189.[3]

The Court in *Ysursa* similarly declined to apply strict scrutiny to a state statute that authorized the deduction of "union fees from a public employee's wages with the employee's 'signed written authorization,'" but prohibited such payroll deductions for union political activities. 555 U.S. at 356. The Court rejected the unions' argument that this content-based "limitation" on the use of "government payroll mechanisms" violated their First Amendment rights. *Id.* at 355. The Court explained that the statute "does not restrict political speech, but rather declines to promote that speech by

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[3] In *Janus* v. *AFSCME*, 138 S. Ct. 2448 (2018), the Court held that the First Amendment rights of *nonmembers* are violated when agency fees are deducted from their wages without their affirmative consent. *Id.* at 2486. In overruling *Abood* v. *Detroit Board of Education*, 431 U.S. 209 (1977), however, the Court's decision in *Janus* did not disturb the principles underlying this Court's decisions in *Davenport* and *Ysursa* rejecting the First Amendment claims of *unions*.

allowing public employee checkoffs for political activities." *Ibid.* Observing that "the State is not constitutionally obligated to provide payroll deductions at all," *id.* at 359, the Court invoked the principle that "[a] legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny," *id.* at 358 (quoting *Regan*, 461 U.S. at 549). The Court therefore concluded that "the State need only demonstrate a rational basis to justify the ban on political payroll deductions." *Id.* at 359.

Although Justice Alito's opinion in *Tam* rejected the government's reliance on *Davenport* and *Ysursa* in the context of a viewpoint-discriminatory provision, 137 S. Ct. at 1762, that opinion did not command a majority on this point. And Justice Alito's summary of *Davenport* and *Ysursa* confirms that the court of appeals erred in treating precedents related to government programs as limited to Spending Clause legislation or physical property. As Justice Alito explained, the Court in *Davenport* and *Ysursa* recognized that lawmakers may choose "to confer a substantial non-cash benefit for the purpose of furthering activities that they particularly desired to promote but not to provide a similar benefit for the purpose of furthering other activities." *Id.* at 1762. That framework describes this case.

3. A decision sustaining the scandalous-marks provision against respondent's First Amendment challenge would have no necessary implications for the constitutionality of analogous limits on copyright registration

The court of appeals was also wrong in suggesting that there is no "principled basis to distinguish between the registration of trademarks and the registration of copyrights under the government program rationale."

Pet. App. 22a. If a hypothetical statute denied registration of copyrights in particular types of creative works, the First Amendment analysis would depend in part on the precise legal consequences of that denial and the justifications offered for it. To the extent that such a law presented a greater risk of interfering with the marketplace of ideas, or imposed a greater burden on expression, than does the denial of trademark registration—*e.g.*, because of differences between trademarks and copyrights, because of differences in the roles played by registration under the two regimes, or because of differences in the preemption, if any, of state law—the First Amendment inquiry would take account of that greater risk or burden.

The legal regimes that protect trademarks and copyrights respectively serve fundamentally different purposes. The "predominant function" of a trademark is "source identification," *Wal-Mart Stores*, 529 U.S. at 212, and "[f]ederal trademark law 'has no necessary relation to invention or discovery,'" *Dastar Corp.* v. *Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003) (citation omitted). By contrast, copyright protects expression itself, *i.e.*, "original works of authorship fixed in a[] tangible medium of expression." 17 U.S.C. 102(a). This Court has described copyright as "the engine of free expression," "suppl[ying] the economic incentive to create and disseminate ideas." *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (citation omitted); see *ibid.* ("[C]opyright's purpose is to *promote* the creation and publication of free expression.").

Because copyrighted creative works are *themselves* the goods that the author seeks to market, rather than simply source identifiers for such goods, content-based

limits on copyright registrability (or on copyright protection) likely would have much more significant effects on the creation and dissemination of protected expression than analogous limits on the registration of trademarks. That would be particularly true if copyright registration could be refused based on a portion of a much longer work, rather than on the work as a whole. Cf. *Miller*, 413 U.S. at 24 (explaining that whether a work is obscene depends on an analysis of the work "as a whole"). And while significant content-based conditions on registrability are a longstanding feature of trademark law, see pp. 25-26, *supra*, those provisions lack any meaningful analogue in past or present copyright statutes. See *Mitchell Bros. Film Grp.* v. *Cinema Adult Theater*, 604 F.2d 852, 855 (5th Cir. 1979) ("Congress has been hostile to content-based restrictions on copyrightability."), cert. denied, 445 U.S. 917 (1980); cf. *Rust*, 500 U.S. at 199-200 (discussing the significance of traditional practices in identifying exceptions to "the general rule that the Government may choose not to subsidize speech"). Nothing in the government's position here would prevent those differences from being taken into account in conducting First Amendment analysis of a (hypothetical) statute that denied registration of copyrights in scandalous works.

4. The court of appeals' concern that the scandalous-marks provision has been applied inconsistently provides no basis for invalidating that provision

The court of appeals also expressed concern that the scandalous-marks provision has been applied inconsistently. Pet. App. 39a-42a. But analysis of whether a mark is scandalous requires consideration of evidence of the mark's meaning in relation to the particular goods and services for which registration is sought and the

context in which the mark is used. See *Boulevard Entm't*, 334 F.3d at 1340. Like analysis of other registrability criteria, it also requires consideration of evidence of "contemporary attitudes," which naturally change over time. *Ibid.*; cf., *e.g.*, *De Walt, Inc.* v. *Magna Power Tool Corp.*, 289 F.2d 656, 660 (C.C.P.A. 1961) ("A word or group of words not descriptive today may, through usage, be descriptive tomorrow."). The fact that some marks bear superficial similarities to others therefore does not establish that the USPTO erred in treating them differently. See *In re St. Helena Hosp.*, 774 F.3d 747, 753 (Fed. Cir. 2014) ("[E]ach case must be decided on its own facts and the differences are often subtle ones.") (citation omitted).

Moreover, the USPTO examines more than 400,000 trademark applications each year. If an individual USPTO examining attorney improperly allows a mark to be registered or improperly refuses registration, that error "do[es] not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). An allegedly erroneous registration may be prevented through an adversarial opposition proceeding, see 15 U.S.C. 1063, 1067, or corrected through the process of administrative cancellation, see 15 U.S.C. 1064, 1067. The agency's decisions in both types of administrative proceedings are subject to judicial review. See 15 U.S.C. 1071. A disappointed applicant who wishes to challenge the examining attorney's refusal of registration may also seek administrative and judicial review. See 15 U.S.C. 1070, 1071. In establishing those mechanisms, Congress recognized that registration errors may occasion-

ally occur, while taking steps to facilitate their correction. Thus, even if respondent could identify clear inconsistencies between particular registration decisions, there would be no sound basis to conclude that the scandalous-marks provision is incapable of principled application.

In any event, concerns about outcomes in individual cases do not justify the "strong medicine" of facial invalidation. *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613 (1973); see *United States* v. *Stevens*, 559 U.S. 460, 473 (2010) (explaining that, "[i]n the First Amendment context," the Court recognizes a "'type of facial challenge,' whereby a law may be invalidated as overbroad if 'a substantial number of its applications are unconstitutional, judged in relation to the statute's plainly legitimate sweep'") (citation omitted). Any alleged inconsistencies reflected in prior USPTO decisions provide no valid basis for holding that the agency must register scandalous marks, including even those "whose offensiveness cannot be reasonably questioned." Pet. App. 41a; see Gov't C.A. Supp. Letter Br. Add. 1 (July 20, 2017).

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted.

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APPENDIX

1. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall[1] specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

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[1] So in original. The word "shall" probably should not appear.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the

mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regu-

lations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person

resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

2. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States

during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe

conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

3. 15 U.S.C. 1053 provides:

Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

4. 15 U.S.C. 1057 provides:

Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed

thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Surrender, cancellation, or amendment by owner

Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the rec-

ords of the United States Patent and Trademark Office and upon the certificate of registration.

(f) Copies of United States Patent and Trademark Office records as evidence

Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of United States Patent and Trademark Office mistake

Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and

effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant's mistake

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

5. 15 U.S.C. 1062 provides:

Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Director shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: *Provided*, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, whereupon such time may be extended.

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Director an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Director shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.

6. 15 U.S.C. 1065 provides:

Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

(1) there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce,

and other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

7. 15 U.S.C. 1111 provides:

Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this

chapter unless the defendant had actual notice of the registration.

8. 15 U.S.C. 1114 provides in pertinent part:

Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to

be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

* * * * *

9. 15 U.S.C. 1115 provides:

Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership

of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however,* That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under

subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

10. 15 U.S.C. 1117 provides:

Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the

case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) for any violation of section 1114(1)(a) of this title or section 220506 of title 36, in a case involving use of a counterfeit mark or designation (as defined in section 1116(d) of this title), the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee, if the violation consists of—

(1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services; or

(2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.

In such a case, the court may award prejudgment interest on such amount at an annual interest rate established under section 6621(a)(2) of title 26, beginning on the date of the service of the claimant's pleadings setting forth the claim for such entry of judgment and ending on the date such entry is made, or for such shorter time as the court considers appropriate.

(c) Statutory damages for use of counterfeit marks

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than $1,000 or more than $200,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than $2,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(d) Statutory damages for violation of section 1125(d)(1)

In a case involving a violation of section 1125(d)(1) of this title, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits, an award of statu-

tory damages in the amount of not less than $1,000 and not more than $100,000 per domain name, as the court considers just.

(e) Rebuttable presumption of willful violation

In the case of a violation referred to in this section, it shall be a rebuttable presumption that the violation is willful for purposes of determining relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name used in connection with the violation. Nothing in this subsection limits what may be considered a willful violation under this section.

11. 15 U.S.C. 1125 provides:

False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or

her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole,

is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action

against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

12. 15 U.S.C. 1127 provides in pertinent part:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * * * *

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

* * * * *

The term "mark" includes any trademark, service mark, collective mark, or certification mark.

* * * * *

The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3,

1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

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